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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,572	01/18/2001	Eva Ackerman	041443-00752	6865

54487 7590 03/07/2007
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EXAMINER

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ART UNIT	PAPER NUMBER
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2831

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	03/07/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/764,572
Filing Date: January 18, 2001
Appellant(s): ACKERMAN ET AL.

*John Wilson Jones
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/20/06 appealing from the Office action
mailed 10/26/05.

Remarks

The Previous Examiner's Answer mailed on 5/17/06 is hereby vacated. A new Examiner's Answer is presented here below:

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interference, or judicial proceeding, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendment after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. After further consideration of applicant's

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arguments, the 35 USC 112, second paragraph rejection of claims 23-27 have been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

the following is a listing of the evidence relied upon in the rejection of claims under appeal.

6,521,834	Dykhoff et al	02-2003
4,163,137	Close Jr	07-1979
6,153,674	Landin	11-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application

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designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 23-27, 37-38, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dykhoff et al (6,521,834).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 23, a method of assisting a compromised barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) comprising:

- a) providing a gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) comprising fire retardant material of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 23-30, column 11 lines 24-67, column 12 lines 1-24) containing an intumescent graphite (see abstract lines 11-14, column 9 lines 3-30, please note that the fire stopping mat include an intumescent compound);
- b) placing the fire retardant gasket 8 between a faceplate 6 and an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, see column 4 lines 30-53, column 14 lines 38-55) adapted to be introduced into the barrier 4 (see fig 1, column 3 lines 20-50, column 4 lines 30-60, column 14 lines 45-52);
- c) coupling the faceplate 6 to the box 10 (see fig 1 , column 3 lines 40-50, column 4 lines 30-54, column 15 lines 1-5);

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and) at least partially reestablishing a fire rating of the barrier (see column 1 lines 15-35, column 2 lines 20-26, column 3 lines 5-50, column 4 lines 54-62, column 14 lines 45-52).

Regarding claim 24, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising coupling the gasket 8 in situ between the faceplate 6 and the box 10 (see fig1, column 3 lines 30-50, column 4 lines 30-62, column 16 lines 10-16).

Regarding claim 25, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including providing the gasket 8 comprises forming the gasket 8 as a separate element (see fig 1, column 3 lines 40-50, column 4 lines 35-40, column 16 lines 10-16) prior to placing the gasket 8 between the faceplate 6 and the box 10 (see fig1, column 4 lines 30-50 and column 16 lines 10-16).

Regarding claim 26, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising forming the gasket 8 on one surface of the faceplate 6 prior to coupling the faceplate 6 to the box 10 (see column 3 lines 40-50, column 4 lines 54-62, column 16 lines 10-16).

Regarding claim 27, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the gasket is being formed by establishing a coating of the fire retardant material onto the faceplate 6 (see column 2 lines 29-35, column 3 lines 40-45,

column 5 lines 1-14).

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Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 37, a method of assisting a compromised barrier (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) comprising: a) installing into a fire rated barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-12, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, column 4 lines 40-45, column 14 lines 38-55), the electrical box 10 compromising the fire resistance of the fire rated barrier (see column 1 lines 5-40, column 2 lines 1-28, column 3 lines 40-50, column 4 lines 30-45),

b) introducing into the electrical box 10 a fire retardant gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines "30-45) of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 20-30, column 11 lines 24-67, column 12 lines 1724) containing an intumescent graphite (see abstract lines 11-14, column 9 lines 3-30, please note that the fire stopping mat include an intumescent compound); and covering the electrical box 10 with a faceplate 6 (see fig 1, column 2 lines 1-10, column 3 lines 40-45, column 4 lines 30-54, column 14 lines 40-55).

Regarding claim 38, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being adhered to the faceplate 6 prior to covering the electrical box 10 with the faceplate 6 (see column 2 lines 1-10, column 3 lines 40-50, column 14 lines 40-50, column 16 lines 10-18).

Regarding claim 40, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being introduced to the electrical box 10 without removing the electrical box 10 from the fire resistant barrier (see fig 1, column 2 lines 10-40, column 3 lines 30-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 1030) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 23-26 and 37-38,40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Close Jr (4,163,137) in view of Landin (6,153,674).

Assembly of the device of Close comprises a method steps of:

Regarding claim 23, a method of assisting a compromised barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) comprising:

- a) providing a gasket 70, 70', 90 (see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, column 4 lines 1-45) comprising fire retardant material of a fire resistant insulative material (please note that the Close disclosed the gaskets 70' may be formed from a single sheet 98, and sheet 98 having fire retardant properties (see column 5 lines 15-45) as well as the gasket may be vulcanized (see column 2 lines 1-5);
- b) placing the fire retardant gasket 70, 70' between a faceplate 50,50' and an electrical box 28 (see figs 3 and 7, column 2 lines 1-5, and the entire column 3) adapted to be introduced into the barrier (see figs 3 and 7 and the entire column 3);
- c) coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7 and the entire column 3 and the entire column 5) ; and d) at least partially reestablishing a fire rating of the barrier (see the entire column 3 and the entire column 6), but fails to disclose the fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite. Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite

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(see column 1 lines 10-15, column 7 lines 15-30) in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62). It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidenced by Landian. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses, and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 24, the modified assembly of Close discloses all of the claimed features as shown above, including coupling the gasket 70, 70' (see figs 3 and 7 of Close) in situ between the faceplate 50, 50' and the box 28 (see figs 3 and 7, column 2 lines 1-5 of Close).

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Regarding claim 25, the modified assembly of Close disclose all of the claimed features as shown above, including the gasket 70, 70' comprises forming the gasket 70, 70' as a separate element (see figs 2-3 and 7 of Close) prior to placing the gasket 70, 70' between the faceplate 50,50' and the box 28 (see figs 3-4 and 7, column 2 lines 1-5 of Close).

Regarding claim 26, the modified assembly of Close disclose all of the claimed features as shown above, including forming the gasket 70, 70' on one surface of the faceplate 50,50' prior to coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7, column 2 lines 1-5 of Close).

Close disclose:

Assembly of the device of Close comprises the method steps of:

Regarding claim 37, a method for assisting a compromised barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) comprising:

- a) installing into a fire rated barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) an electrical box 28 (see figs 3,7 and the entire column 3) , the electrical box 28 compromising the fire resistance of the fire rated barrier (see the entire specification),
- b) introducing into the electrical box 28 a fire retardant gasket 70, 70', 90 ((see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, and the entire column 5); and covering the electrical box 28 with a faceplate 50, 50'(see figs3,7 and the entire column 3 and the column 6), but fails to disclose the fire retardant gasket of a fire resistant insulative material containing mineral wool or intumescent graphite.

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Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62). It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidence by Landian. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses , and it has been held to be within the general skill of a worker in the art to select a known material on the basis

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of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 38, the modified assembly of Close disclose all of the claimed features as shown above, including the fire retardant gasket being adhered to the faceplate prior to covering the electrical box 28 with the faceplate (see fig 3 and the entire specification of Close).

Regarding claim 40, the modified assembly of Close disclose all of the claimed features as shown above, including the fire retardant gasket being introduced to the electrical box 28 without removing the electrical box from the fire resistant barrier (see fig 3, and the entire specification of close).

(10) Response to Arguments

Appellant's arguments filed have been fully considered but they are not persuasive.

Specifically, the appellant argues the following:

A) Appellant's argument 1 that claims 23-27 are definite, including the metes and bounds of their claimed invention and thus the rejection under 35 USC 112, second paragraph should be reversed.

With respect to argument A, the examiner respectfully submits that this rejection is moot in view of the withdrawal of the 35 USC 112, second paragraph.

B) Appellant's argument 2 that during the protracted prosecution of this application, the Examiner has never provided any guidance to Appellants as to the alleged insufficiency of the showings submitted by Appellants but has consistently made the conclusory statements that the Exhibits are "insufficient" and 37 CFR 1.131 only

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requires the Declaration to " establish invention of the subject matter of the rejected claim prior to the effective date of the reference.... " in light of the previously submitted Declaration, the rejection of the claims over Dykhoff should not be maintained.

With respect to argument B, the examiner respectfully traverses because item 1 of the final rejection dated 10/26/05, clearly explained that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897 as cited at MPEP 706.02(1)(2)). The applicant has failed to provide the following with respect to Declaration in Exhibits A through E for claims 23 and 27:

For claim 23: a method of assisting a compromised barrier comprising: placing the fire retardant gasket between a faceplate and an electrical box, coupling the faceplate to the box, and at least partially reestablishing a fire rating of the barrier. No data related to any fire rating as well as at least partially reestablishing a fire rating of the barrier For claim 37, a method of assisting a compromised barrier comprising: installing into a fire rated barrier an electrical box, introducing into the electrical box a fire retardant gasket, and covering the electrical box with a faceplate.

The Exhibits A-E provide the following:

Exhibit A discussed a gasket for cover plates and two successful tests of gaskets.

Exhibit B discussed electrical box inserts.

Exhibit C discussed a metal and standard metal.

Exhibit D discussed a plate, a box, hole and cold faces.

Exhibit E testing of 1.5 mm blazeseal electrical plate covers.

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Exhibits A through E are insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference.

C) Appellant's argument 3 that the gasket may exhibit fire retardant properties, the gasket of Close does not exhibit the claimed fire resistant insulative properties. The gasket of Close is plastic. Plastics are not fire resistant insulative material.

With respect to argument C, the examiner respectfully traverses because the fire retardant properties of the gasket of Close meet the claimed structure limitations because it would slow a fire in the progress, serves to form a fire barrier in the event of a fire and prevent the spread of fire and passage of smoke. Applicant admits in his argument 3 that the gasket is fire retardant and air-impervious. This is fire resistant, since resistant and retardant are not significantly different in any patentable sense argued by applicant, further air-impervious keeps out oxygen, which is required for any fire, so that the gasket is fire resistant, applicant then states plastics are not insulative. This argument is without merit since plastics do not conduct electricity or heat, such as a metal, so any distinction is not clear.

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D) Appellant's argument 3 that there is no reason to substitute the intumescent material of Landin for the "spongy, compressible, sealing gaskets or thin non compressible but flexible" of close.

With respect to argument D, the examiner respectfully traverses because the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

E) Appellant's argument 3 that in any event, Close fails to disclose the methodology that is the crux of Appellants' invention. The compromised barrier of Appellants' claims has a defined fire rating.

With respect to argument E, the examiner respectfully traverses because claims do not claim a defined fire rating.

F) Appellant's argument 3 that no motivation exists as to why one would have combined the references.

With respect to argument F, the examiner respectfully traverse because Landin reference teaches the use of a fire barrier material being especially useful in providing fire protection for electrical systems (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column

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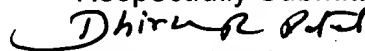
7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62). Therefore, suggestion in the Landin reference is a proper motivation for combining the teaching of Landin, and that the 35 USC 103(a) rejection is proper.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and interferences section of this examiner's answer. For the above reasons, it is believed that the rejections should be sustained.

Respectfully Submitted.


Dhuru R. Patel

Primary Examiner 2831

Conferees:

Dean Reichard (SPE) 

Darren Schuberg (SPE) 

Dhuru R. Patel. 